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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|-------------------------------------|-------------|------------------------|----------------------|------------------|
| 10/025,337                          | 12/19/2001  | Andrew Amadeo Munarriz | 015719-0000 (B74051) | 3463             |
| 20594                               | 7590        | 08/12/2005             | EXAMINER             |                  |
| AKIN GUMP STRAUSS HAUER & FELD, LLP |             |                        | NGUYEN, MAIKHANH     |                  |
| P O BOX 688                         |             |                        | ART UNIT             |                  |
| DALLAS, TX 75313-0688               |             |                        | PAPER NUMBER         |                  |
|                                     |             |                        | 2176                 |                  |

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/025,337             |  | MUNARRIZ ET AL.     |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Maikhanh Nguyen        |  | 2176                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) 69-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/11/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. The Amendment received 04/11/2005 has been entered and carefully considered. Claims 16 and 20-26 are currently pending in this application. Claims 16, 21-23 have been amended. Claims 1-15 have been canceled. Claims 69-98 have been added which raise new subject matters that are not originally presented; therefore, are withdrawn from consideration.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # **0030944.3** filed in **UNITED KINGDOM** on 12/19/2000, which papers have been placed of record in the file.

***Original Presentation***

3. Newly submitted claims 69-98 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
  - (i) Claims 16 and 20-26, drawn to a messaging system arranged to transmit messages, classified in class 709, subclass 219.
  - (ii) Claims 69-98 drawn to a server transmitting the converted email and instant messaging messages to a client, classified in class 709, subclass 230.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 69-98 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Objections*

4. Claims 20-26 are objected to because of the following informalities:  
  
Claims 20 - 26 should start with "the message system" as they are referring to "a message system" of claim 16. Appropriate correction is required.

### *Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 16 and 20-26 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bose et al.** (U.S. Patent Application Publication 2002/0042830, filed 04/2001, priority 03/2000).

**As to independent claim 16:**

Bose teaches (*Abstract*) message system (*system*) arranged to transmit (*transmitted*) messages (*message*) comprising:

A server (*web server; para.0092*) using an XML message (*the XML format of the message; para.0092*) containing, among other things, an instant messaging message (*instant messaging; paras.0022-0024*), and storing the XML message (*the message may be stored...stored messages; para.0081*) wherein the message comprises:

a format (*the XML format of the message; para.0092*) having delimiters that both mark regions containing values of fields; and identify which fields those are (*para.0092 shows the fields of the XML message that are identified as, among other fields, CS010-Student1 field for receiving the response and Your teacher field for sending the response*).

**As to dependent claim 20:**

Bose teaches a field, in said format, indicating an action to be carried out on the message indicates that (*para.0096 shows an XML representation of the message format having the plurality of fields, such as choice1, choice2, choice3 and choice4 for performing an action to be carried out on the message when one of the choices is selected*).

**As to dependent claim 21:**

Bose teaches the field indicating the action to be carried out on the message indicates that the message is to be sent *para.0096-0098 shows that choice2 is selected by the user and the response will be sent to the poll initiator*).

**As to dependent claim 22:**

Bose teaches the field indicating the action to be carried out on the message indicates that the message is to be stored (*store messages; para.0081*).

**As to dependent claim 23:**

Bose teaches the field indicating the action to be carried out on the message indicates that the message is to be deleted (*the message may be discarded; para.0073*).

**As to dependent claim 24:**

Bose teaches arranged to transfer messages in the format using a HTTP protocol

**As to dependent claim 25:**

Bose teaches the HTTP protocol is HTTPS (*HTTPS; para.0068*).

**As to dependent claim 26:**

Bose teaches the messages transferred using HTTP are in XML format (*XML data presentation format; paras.0069 and 0092*).

***Response to Arguments***

6. Applicant's arguments filed 04/11/ 2005 have been fully considered but they are not persuasive.

- a. Applicant argues *that Bose fails to provide a basis for the rejection of claims under 35 U.S.C. 102, because it fails to disclose each element of claimed invention. Claims 16 includes a “ messaging system arranged to transmit messages comprising: A server using an XML message containing an SMTP email message **and** an instant messaging message, and storing the XML message wherein the message comprises: a format having delimiters that both mark regions containing values of fields; and identify which fields those are.* (Remarks, page 3)
- b. In response, the amended claim 16 recites “*a server using an XML message containing an SMTP email message **or** an instant messaging message*”, not “*a server using an XML message containing an SMTP email message **and** an instant messaging message*”. The rejection above clarifies how Bose meet the claim limitations as amended by Applicant.

Claimed subject matter, not the specification is the measure of the invention.

Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution (see *In re Prater*, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Halahmi                      U.S. Patent No. 6,684,0888                      Issued: Jan. 27, 2004

Hogan et al.                      U.S. Patent No. 6,785,712                      Issued: Aug. 31, 2004

Chesnais et al.                      U.S. Publication 2002/0087704 A1                      Pub. Date: Jul. 4, 2002

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.



The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
8/4/2005